



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No. 13

KENYON & KENYON
One Broadway
New York, NY 10004

COPY MAILED

APR 06 2004

OFFICE OF PETITIONS

In re Application of
Hans-Joerg Mathony
Application No. 09/960,571
Filed: September 21, 2001
Attorney Docket No. 10191/1917

:
:
: DECISION DISMISSING
: PETITION
:

This is a decision on the "Request for Reconsideration of Decision to Dismiss Request to Accord a Filing Date of September 12, 2001 and Petition Under 37 C.F.R. § 1.183" filed February 19, 2004, again requesting that the above-identified application be accorded a filing date of September 12, 2001.

A request that the above-identified application be accorded a filing date of September 12, 2001, was submitted with the application papers on filing. A decision dismissing the request was mailed on December 18, 2003. On February 19, 2004, the present request for reconsideration and petition (hereinafter referred to as petition) was filed.

37 CFR 1.6(e) states that:

If interruptions or emergencies in the United States Postal Service which have been so designated by the Commissioner occur, the Patent and Trademark Office will consider as filed on a particular date in the Office any correspondence which is:

- (1) Promptly filed after the ending of the designated interruption or emergency; and
- (2) Accompanied by a statement indicating that such correspondence would have been filed on that particular date if it were not for the designated interruption or emergency in the United States Postal Service.

35 U.S.C. 21(a) states that:

The Director may by rule prescribe that any paper or fee required to be filed in the Patent and Trademark Office will be considered filed in the Office on the date on which it was deposited with the United States Postal Service or would have been deposited with the United States Postal Service but for postal service interruptions or emergencies designated

by the Director. (Emphasis added.)

In the previous decision, it was acknowledged that the U.S. Patent and Trademark Office (Office) designated the interruption in the service of the USPS in the borough of Manhattan as a postal service interruption and emergency within the meaning of 35 U.S.C. 21(a), with the provisions of 37 CFR 1.6(e) in effect, and also designated the interruption in the Express Mail service of the USPS as a postal service interruption within the meaning of 35 U.S.C. 21(a) and 37 CFR 1.6(e). See "United States Postal Service Interruptions", 1251 *Off. Gaz. Pat. Office* 55 (October 9, 2001).

As stated in the prior decision, the statute requires that the correspondence being filed in the Office would have been deposited with the United States Postal Service (USPS) but for **postal service** interruptions or emergencies. Thus, the statute requires that: (1) the application papers being filed must be complete and ready to be deposited with the USPS on the filing date requested by applicants, and (2) the complete application papers could not be deposited with the USPS for the **sole reason** that the postal service was not available due to the interruption or emergency designated by the Office.

Petitioner disagrees with this statement as to what the statute requires and argues that the request fully complies with the requirements of 35 U.S.C. 21(a) and 37 CFR 1.6(e). Petitioner argues that the statute does not impose any substantive requirements on applicants and that the language of the statute "indicates that Congress intended to leave it up to the Director to decide how applicants can show entitlement to a filing date earlier than the actual date of receipt." Petitioner cites the legislative history for support. Petitioner further argues that 37 CFR 1.6(e) merely requires applicant to submit "a statement indicating that such correspondence would have been filed on a particular date if it were not for the designated interruption or emergency in the United States Postal Service." Since such a statement has been submitted, petitioner argues that the Office must accord the application a filing date of September 12, 2001.

The Office does not have the authority to promulgate rules that would exceed its statutory authority. Thus, the Office can only accord a filing date under 37 CFR 1.6(e) where the requirements of 35 U.S.C. 21(a) have been met, namely, that the correspondence would have been deposited with the United States Postal Service but for the postal service interruption or emergency designated by the Director. Where the Office has reason to believe that a statement under 37 CFR 1.6(e) may not be true, it has the inherent authority to question the statement to determine whether the applicant is, in fact, entitled to the requested filing date under 35 U.S.C. 21(a) and 37 CFR 1.6(e). In this case, there is evidence that clearly contradicts the statement that was made on filing since the transmittal letter for the application was dated September 21, 2001.

The previous decision noted that the transmittal letter for the application was dated September 21, 2001, and stated that it did not appear that the application was prepared and ready to be deposited

with the USPS on September 12, 2001. The request for reconsideration fails to address this issue. The fact that the applicants' attorney's office was inaccessible to the attorney on September 12, 2001, due to the World Trade Center attack and the attorney was diligent in filing the application papers once his office resumed its normal operations would not be sufficient to establish that the application was ready to be deposited with the USPS on September 12, 2001. The record shows that the transmittal letter for the application was dated September 21, 2001. The Office simply cannot accept applicant's statement when the evidence contradicts the statement and applicants have not provided an adequate explanation or additional evidence to show that the application papers were complete and ready to be deposited with the USPS on September 12, 2001.

The petition was accompanied by a "Statement of Dervis Magistre..." in which Mr. Magistre states that he "was personally responsible for preparing the above-captioned application for filing in the United States Patent and Trademark Office" and he "had completed the application papers, i.e., the four pages of Specification, the one page containing five claims, the one page of Abstract, and the two pages of Figures, that were deposited with the United States Postal Service on September 21, 2001, no later than September 12, 2001."

The statement of Mr. Magistre was made approximately two years and five months after the application was filed. No objective evidence to corroborate Mr. Magistre's statement that he completed the application papers that were deposited with the USPS on September 21, 2001, no later than September 12, 2001, has been submitted. It is unclear how an individual involved in the day-to-day preparations of papers for filing in the USPTO can recall exactly what papers were completed by "no later than" a particular date when those papers were prepared approximately two years and five months earlier.

In the alternative, petitioner requests that the "alleged requirements of 35 U.S.C. § 21(a) and 37 C.F.R. § 1.6(e) be suspended or waived so that a filing date of September 12, 2001 can be accorded to the present application." Petitioner argues that the events of September 11, 2001, constitute "an extraordinary situation" under 37 C.F.R. § 1.183, and justice requires that the Office accord a filing date of September 12, 2001 to the present application.

37 CFR 1.183 states, in part, that:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party subject to such other requirements as may be imposed. (Emphasis Added.)

As noted above, the statute requires that the correspondence being filed in the Office would have been deposited with the United States Postal Service (USPS) but for postal service interruptions or emergencies. 37 CFR 1.183 does not give the Office the authority to waive a requirement of

the statute. Therefore, the petition under 37 CFR 1.183 cannot be granted.

It is again noted that the application includes a claim for foreign priority based on a German application filed September 12, 2000. An applicant may delay action until the end of the time period for taking action, but are acting at their own peril when doing so. See Ziegler et al. v. Baxter et al. v. Natta et al., 159 USPQ 378 (ComrPats 1968). Since the above-identified application has been accorded a filing date of September 21, 2001, which is more than one year after the filing date of the German application, the claim for foreign priority **cannot** be accepted. Office records have been corrected accordingly. A corrected filing receipt is attached.

The previous decision has been reconsidered as requested. The result, however, is the same.

In view of the above, the petition is dismissed.

Any request for reconsideration should be filed within **TWO MONTHS** of this decision in order to be considered timely (see 37 CFR 1.181(f)) and should be directed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Eugenia Jones
 Office of Patent Legal Administration

By hand: U.S. Patent and Trademark Office
 2011 South Clark Place
 Customer Window, Mail Stop Petition
 Crystal Plaza Two, Lobby, Room 1B03
 Arlington, VA 22202

Applicant is cautioned, however, that any further request for reconsideration that fails to address the issue of why the transmittal letter is dated September 21, 2001, may be considered a failure to engage in reasonable efforts to conclude prosecution of the application under 37 CFR 1.704. See "Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term", Final Rule, 65 Fed. Reg. 56365, 56371 (Sept. 18, 2000).

The application is being returned to Technology Center 2100.

Telephone inquiries specific to this matter should be directed to the undersigned at (703) 306-5586.

A handwritten signature in cursive script that reads "Eugenia A. Jones". The signature is written in black ink and is positioned above the printed name.

Eugenia A. Jones
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

Attachment: Corrected Filing Receipt